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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/590,027

08/18/2006

Hiroto Kidokoro

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7590

04/23/2009

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EXAMINER

LE, HOA VAN

ART UNIT

PAPER NUMBER

1795

MAIL DATE

DELIVERY MODE

04/23/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/590,027	<b>Applicant(s)</b> KIDOKORO, HIROTO	
	<b>Examiner</b> Hoa V. Le	<b>Art Unit</b> 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/18/06 02/08/08</u> .                                       | 6) <input type="checkbox"/> Other: ____.                          |

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This application is up for consideration.

I. Applicant's prior art submissions have been considered to the extent of the English language as provided.

II. It is recognized that WO 02/29497 A2 has (1) a publication date of 04/11/02, (2) equivalent teachings and/or suggestion as 7,422,833 and 2004/0013961 and (3) same Zeon Corp. assignee.

(A) A broad or narrow statement or argument to the applied WO 02/29497 by assignee and/or their counsel in this application will be consistently applied to 7,422,833.

(B) WO 02/29497 is selected because the works in the instant application and those in WO 02/29497 are done at Zeon Corp. Lab.

III. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oyama et al (WO 02/29497).

Oyama et al disclose, teach and suggest an electrographic toner composition comprising color resin particles having an average particle size ( $D_v$ ) of 2- 8 microns, particle diameter distribution ratio( $D_v$ )/( $D_p$ ) of less than 1.3, spheroidicity ratio  $r_l/r_s$  of from 1 and containing a binder resin, a colorant, a charge control agent, a parting agent. Please see the whole disclosure of the applied reference, especially in Oyama et al on at least page 4, last line to page 11, line 7, 23 to page 12, line 3, page 13, lines 5-9, page 15, lines 12-22, 28 to page 16, lines 5, 14-14, page 19, line 4-18, page 20, lines 1-5, 22 to page 22, line 5, page 25, lines 4-7, 12-22, second line from the bottom of page 31, line 20 and Examples. At the level of one skilled in the art and/or an average skill artisan at the time the invention was made would recognize that the applied toner compositions have (1) a range of circularity (spheroidicity), a range of share viscosity...8,000 Pa.s, a range of share viscosity...1,300 Pa.s, a ratio of range of volatilization up to 130°C/ range of volatilization above 130°C when measurements are made. Therefore, it is urged and requested applicant, assignee and/or their counsel to early, timely and candidly show or provide convincing evidence to the contrary for an

early consideration, examination and properly allowance of the claims to avoid a costly and lengthy litigation during and after an allowance of a claim. Evidence being not considered during the prosecution must be firstly considered and taken to a full and complete satisfaction before allowing or permitted any other issue to be taken. For a patentability of “tone...having the following properties...”, it is allowed by law to request and require applicant, assignee and/or their counsel to provide or show convincing evidence to the contrary. An allowed claim or patent would have no value when someone reasonably show to the same or obviously about same claimed properties using all possible combinations of the broad teachings and/or suggestions from the applied reference. The language “produced by” in claims 13-15 and 19 is a product-by-process. According to the MPEP, "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." (MPEP 2113 [R-I], see *In re Thorpe*, 777F.2d 695, 698,227 USPQ

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964,966). In this case, Oyama et al also disclose, teach and suggest the toner composition being made by a polymerization as that in the claimed. In the absence of convincing evidence to the contrary as early, timely and clearly pointed out and set forth on the record, the claims are not found to be allowable and rendered prima facie obvious by Oyama et al.

IV. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 7:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Hoa V. Le/

Primary Examiner, Art Unit 1795

01/04/08